

**REMARKS****Summary of the Office Action**

Claims 1-3 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bernhardt (U.S. Patent No. 2,809,554) (hereinafter “Bernhardt”).<sup>1</sup>

Claims 4 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bernhardt.

Claims 1 and 10 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite.

Claims 5-8, while objected to as being dependent upon a rejected base claim, would be allowable if rewritten in independent form.

**Summary of the Response to the Office Action**

Applicants have amended each of claims 1, 9 and 10 to differently describe embodiments of the disclosure of the instant application and/or to improve the form of the claims. Accordingly, claims 1-10 currently remain pending for consideration.

**Rejections under 35 U.S.C. § 112, Second Paragraph**

Claims 1 and 10 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. Applicants have amended claims 1 and 10 to improve the form of the claims in light of the Examiner’s comments at page 5 of the Office Action in this regard.

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<sup>1</sup> Applicants understand that the Examiner’s repeated references to “Brenhardt” in the Office Action are typographical errors that are intended to instead refer to “Bernhardt.” To the extent that Applicants’ understanding is incorrect, clarification is respectfully requested to be provided by the Examiner in the next Office Communication.

For example, with regard to claim 1, the Examiner alleges at page 5 of the Office Action that the phrase “an attaching surface to the observed object” is “not explicitly disclosed in the claim.” As a result, the Examiner notes that it “is not clear whether the attaching surface is part of the lens, the object examined, or another object.” In response, Applicants have amended claim 1 to clearly describe that the solid immersion lens has a bottom surface including the attaching surface. As a result, Applicants respectfully submit that the attaching surface is part of the solid immersion lens.

With regard to claim 10, the Examiner alleges at page 5 of the Office Action that the phrase “optical coupling material feeding unit” is “not explicitly disclosed in the claim.” In response, Applicants have amended claim 10 to clearly describe that the feeding unit is a dripping unit for dripping the optical coupling material on the observation point of the observed object. Applicants refer to paragraphs 0060, 0067 and 0096 of the specification of the instant application in this regard.

Accordingly, Applicants respectfully submit that claim 1 and 10, as amended, fully comply with 35 U.S.C. § 112, second paragraph. Accordingly, withdrawal of the rejections under 35 U.S.C. § 112, second paragraph is respectfully requested.

#### **Rejections under 35 U.S.C. §§ 102(b) and 103(a)**

Claims 1-3 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bernhardt. Claims 4 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bernhardt. Claims 1, 9 and 10 have been newly-amended to differently describe embodiments of the disclosure of the instant application. To the extent that these rejections might be deemed to

still apply to the claims as newly-amended, they are respectfully traversed for at least the following reasons.

Applicants have newly-amended independent claim 1 to describe an advantageous combination of features of a solid immersion lens that is a lens which is to be positioned on the optical axis from the observed object to the optical system including the objective lens. At page 2 of the Office Action, the Examiner asserts that the applied Bernhardt references teaches “[a]n attaching surface to the observed object is formed in a toroidal shape (See figure 1, examiner interpret attaching surface as lens surface).” However, Applicants respectfully traverse such assertions because the lens element disclosed in Bernhardt is a ring-shaped condenser lens for dark-field illumination, and for the purpose of the dark-field illumination, as clearly shown in Fig. 6, the dark-field condenser lens 10 of Bernhardt has a central boring for reception of a front lens mount 5 of the objective lens. See col. 4, lines 54-70, Fig. 6 and Claim 1 of Bernhardt. Applicants respectfully submit that because of the above-described structure with the central boring, the condenser lens of Bernhardt is not positioned (and cannot be positioned) on the optical axis of the objective lens.

On the other hand, Applicants respectfully submit that, as clearly described in newly-amended independent claim 1 of the instant application, as well as claim 9, the solid immersion lens of the present invention is positioned on the optical axis of the optical system. Further, Applicants respectfully submit that the solid immersion lens has a spherical surface of the objective lens side and a bottom surface of the observed object side including the attaching surface to be attached to the observed object. Additionally, the attaching surface to the observed object is formed in a toroidal shape. Thus, Applicants respectfully submit that the solid

immersion lens of the present invention is completely and significantly different from the lens element disclosed in Bernhardt.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. §§ 102(b) and 103(a) should be withdrawn because Bernhardt does not teach or suggest each feature of claims 1-4, 9 and 10 of the instant application. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Similarly, MPEP § 2143.03 instructs that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.' In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)."

The Examiner is thanked for the indication that claims 5-8, while objected to as being dependent upon a rejected base claim, would be allowable if rewritten in independent form. However, Applicants respectfully submit these claims are also in condition for allowance at least for the reasons discussed above with regard to their respective independent claim. Accordingly, withdrawal of the objection to claims 5-8 is respectfully requested.

### CONCLUSION

In view of the foregoing amendments and remarks, withdrawal of the rejections and allowance of all pending claims are earnestly solicited. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573.

This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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